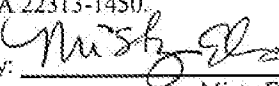


**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

<p>In re the Patent Application of:</p> <p>Applicant: Steven P. Masterson et al.</p> <p>U.S. Serial No.: 10/591,806</p> <p>International App. No. PCT/US05/07936</p> <p>U.S. Filing Date: September 6, 2006</p> <p>IA Filing Date: March 8, 2005</p> <p>Title: Improved Apparatus for Electrically Mediated Delivery of Therapeutic Agents</p>	<p>Confirmation No.: 4733</p> <p>Group Art Unit: 3762</p> <p>Examiner: Not yet assigned</p>
	<p><u>Certificate of Electronic Filing</u></p> <p>I hereby certify that the attached Response to Office Action and all marked attachments are being deposited by Electronic Filing on November 30, 2009 by using the EFS – Web patent filing system and addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.</p> <p>By:  Misty Elam</p>

**RESPONSE TO DECISION ON PETITION DATED SEPTEMBER 30, 2009**

Applicants hereby submit a request for reconsideration of the Decision on Petition dated September 30, 2009. The two-month deadline for response is November 30, 2009. Applicants believe that this response is being timely filed. However, in the event that Applicants are incorrect, please charge any necessary fee to Deposit Account No. 23-2415, referencing Docket No. 34149-712.831. Applicants respectfully request reconsideration of the petition filed in this matter on June 2, 2009.

**REMARKS**

On June 2, 2009, Applicants submitted a Petition for Revival of an International Application for Patent Designating the U.S. Abandoned Unintentionally Under 37 CFR 1.137(b). On July 29, 2009, a Decision on Petition was mailed to Applicants. Applicants thank Examiner Dombroske for finding that the petition satisfies the requirements for satisfactory statement of unintentional delay, confirms that no terminal disclaimer is required, and satisfies the requirements for Deposit Account authorization in the amount of \$810. The Examiner's Decision on Petition indicates that the Petition for Revival has been denied based on an alteration of inventor Steven Masterson's mailing address on the declaration filed on June 2, 2009, which alteration was not initialed by Mr. Masterson at the time of filing.

Applicants subsequently submitted a newly-executed declaration by Mr. Masterson reflecting his correct mailing address with no alterations and paid a second Petition for Revival fee. Applicants further resubmitted the declarations of the other inventors along with a copy of the Petition for Revival as originally submitted on June 2, 2009. Thus, in *both* the Petition for Revival submitted on June 2, 2009, and in the August 6, 2009 renewed petition for revival, the declarations of the entire inventive entity was submitted. The submission of August 6, 2009 corrected that which was deficient in the June 2, 2009 submission namely, Mr. Masterson's declaration; however, it also included the declarations of the other inventors from the June 2, 2009 submission—albeit not on sequential pages. The fact that these declarations were not provided in a sequential set of pages does not diminish the fact that all declarations were submitted and that Applicants have identified the entire inventive entity in the August 6, 2009 submission.

Nevertheless, on September 30, 2009, a Decision on Petition was mailed to Applicants indicating that full inventorship was not disclosed on the new declaration bearing Mr. Masterson's unaltered mailing address—despite the fact that the declarations of the other two inventors were also sent along with Mr. Masterson's newly-executed declaration in Applicants' August 6, 2009 submission. It is arbitrary and capricious to deny the second submission of the declarations of the entire inventive entity simply because these documents were not presented sequentially. The totality of the submission on August 6, 2009 as well as

inventorship itself make it clear that a full record was presented and the entire inventive entity was identified.

In an effort to advance the Petition for Revival to grant, Applicants herewith submit a revised declaration by Mr. Masterson identifying the entire inventive entity on sequential pages, along with a copy of the previously-submitted declaration bearing the un-initialed change to Mr. Masterson's mailing address and the declarations of the other two inventors Mr. Bernard and Mr. Hannaman and a copy of the Petition for Revival as originally submitted on June 2, 2009.

### CONCLUSION

Applicants respectfully request reconsideration by the Examiner of the Petition for Revival. It is believed that the submission of August 6, 2009, alone or certainly in combination with the submission of June 2, 2009, was complete and sufficient to satisfy the deficiencies noted by the USPTO. For this reason, it is urged that no additional fees should be required for the USPTO to grant this petition. However, in the event that any additional petition fee is deemed necessary, the Commissioner is authorized to charge any additional fees which may be required, including petition fees and extension of time fees, to Deposit Account No. 23-2415 (Docket No. 34149-712.831).

Should the Examiner have any questions, the Examiner is encouraged to contact the undersigned attorney at (858) 350-2300.

Respectfully submitted,

WILSON SONSINI GOODRICH & ROSATI



Peter R. Munson, Esq.  
Reg. No. 43,821

Date: November 30, 2009

650 Page Mill Road  
Palo Alto, CA 94304  
(858) 350-2300  
Customer No. 021971

**PETITION FOR REVIVAL OF AN INTERNATIONAL APPLICATION FOR PATENT  
DESIGNATING THE U.S. ABANDONED UNINTENTIONALLY UNDER 37 CFR 1.137(b)**

 Docket Number  
(Optional)

First Named Inventor: Steven P. Masterson

International (PCT) Application No.: PCT/US05/07936

 U.S. Application No.: 10/591,806  
(if known)

IA Filed: IA Filing Date 03/08/05

U.S. Filed: 09/06/06

Title: Improved Apparatus for Electrically Mediated Delivery of Therapeutic Agents

 Attention: PCT Legal Staff  
Mail Stop PCT  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

The above-identified application became abandoned as to the United States because the fees and documents required by 35 U.S.C. 371 (c) were not filed prior to the expiration of the time set in 37 CFR 1.495(b) or (c) as applicable. The date of abandonment is the day after the date on which the 35 U.S.C. 371 (c) requirements were due. See 37CFR1.495(h).

**APPLICANT HEREBY PETITIONS FOR REVIVAL OF THIS APPLICATION**

NOTE: A grantable petition requires the following items:

- (1) Petition fee
- (2) Proper reply
- (3) Terminal disclaimer with disclaimer fee which is required for all international applications having an international filing date before June 8, 1995; and
- (4) Statement that the entire delay was unintentional.

**1. Petition fee**
☒ Small entity - fee \$810.00 (37 CFR 1.17(m)). Applicant claims small entity status.

See 37 CFR 1.27. The Commissioner is hereby authorized to charge the petition fees of \$810.00, Missing Requirements fees of \$568.00, and charge any additional fees or credit any overpayment associated with this communication to Deposit Account No. 23-2415 (Docket No. 34149-700).

☐ Other than small entity - fee \$\_\_\_\_ (37 CFR 1.17(m))

**2. Proper reply**

 A. The proper reply (the missing 35 U.S.C. 371 (c) requirement(s)) in the form of  
Notification and Declaration \_\_\_\_\_ (identify type of reply):

☐ has been filed previously on \_\_\_\_\_.

☒ is enclosed herewith.

[Page 1 of 2]

This collection of information is required by 37 CFR 1.137(b). The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 1.0 hour to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop PCT, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

## 3. Terminal disclaimer with disclaimer fee

- ☐ Since this international application has an international filing date on or after June 8, 1995, no terminal disclaimer is required.
- ☐ A terminal disclaimer (and disclaimer fee (37 CFR 1.20(d)) of \$\_\_\_ for a small entity or \$\_\_\_ for other than a small entity) disclaiming the required period of time is enclosed herewith (see PTO/SB/63).

4. Statement. The entire delay in filing the required reply from the due date for the required reply until the filing of a grantable petition under 37 CFR 1.137(b) was unintentional.

**WARNING:**

Petitioner/applicant is cautioned to avoid submitting personal information in documents filed in a patent application that may contribute to identity theft. Personal information such as social security numbers, bank account numbers, or credit card numbers (other than a check or credit card authorization form PTO-2038 submitted for payment purposes) is never required by the USPTO to support a petition or an application. If this type of personal information is included in documents submitted to the USPTO, petitioners/applicants should consider redacting such personal information from the documents before submitting them to the USPTO. Petitioner/applicant is advised that the record of a patent application is available to the public after publication of the application (unless a non-publication request in compliance with 37 CFR 1.213(a) is made in the application) or issuance of a patent. Furthermore, the record from an abandoned application may also be available to the public if the application is referenced in a published application or an issued patent (see 37 CFR 1.14). Checks and credit card authorization forms PTO-2038 submitted for payment purposes are not retained in the application file and therefore are not publicly available.

Peter R. Munson  
Signature

2 June 2009  
Date

Peter R. Munson

Typed or Printed Name

43,821

Registration Number, if applicable

Wilson Sonsini Goodrich & Rosati

Address

650-493-9300

Telephone Number

650 Page Mill Road, Palo Alto, CA 94304-1050

Address

- Enclosures: ☒ Response to  
Notification of Missing  
Requirements
- ☒ Fee Payment
- ☐ Terminal Disclaimer
- ☒ Other (please identify): Declaration



## UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22311-1450  
www.uspto.gov

U.S. APPLICATION NUMBER NO.	FIRST NAMED APPLICANT	ATTY. DOCKET NO.
10/591,806	Steven P. Masterson	P00262US1

INTERNATIONAL APPLICATION NO.

PCT/US05/07936

I.A. FILING DATE

03/08/2005

PRIORITY DATE

03/08/2004

Law Offices of James C. Weseman  
401 W A Street  
Suite 1600  
San Diego, CA 92101-7906

CONFIRMATION NO. 4733

371 FORMALITIES LETTER



\*OC000000023822180\*

Date Mailed: 05/11/2007

### NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 IN THE UNITED STATES DESIGNATED/ELECTED OFFICE (DO/EO/US)

The following items have been submitted by the applicant or the IB to the United States Patent and Trademark Office as a Designated / Elected Office (37 CFR 1.495).

- Indication of Small Entity Status
- Copy of the International Application filed on 09/06/2006
- Copy of the International Search Report filed on 09/06/2006
- U.S. Basic National Fees filed on 09/06/2006
- Priority Documents filed on 09/06/2006
- Specification filed on 09/06/2006
- Claims filed on 09/06/2006
- Abstracts filed on 09/06/2006
- Drawings filed on 09/06/2006

The applicant needs to satisfy supplemental fees problems indicated below.

The following items **MUST** be furnished within the period set forth below in order to complete the requirements for acceptance under 35 U.S.C. 371:

- Additional claim fees of \$200 as a small entity, including any required multiple dependent claim fee, are required. Applicant must submit the additional claim fees or cancel the additional claims for which fees are due.
- Oath or declaration of the inventors, in compliance with 37 CFR 1.497(a) and (b), identifying the application by the International application number and international filing date.

## SUMMARY OF FEES DUE:

Total additional fees required for this application is \$300 for a Small Entity:

- The application examination fee has not been paid. Applicant must submit \$100 to complete the examination fee for a small entity in compliance with 37 CFR 1.27. Note a surcharge will be required if submitted later than commencement of the national stage (37 CFR 1.492(h)) and the basic national fee was not paid before July 1, 2005.
- Total additional claim fee(s) for this application is \$ 200
  - \$200 for 18 total claims over 20.

**ALL OF THE ITEMS SET FORTH ABOVE MUST BE SUBMITTED WITHIN TWO (2) MONTHS FROM THE DATE OF THIS NOTICE OR BY 32 MONTHS FROM THE PRIORITY DATE FOR THE APPLICATION, WHICHEVER IS LATER. FAILURE TO PROPERLY RESPOND WILL RESULT IN ABANDONMENT.**

The time period set above may be extended by filing a petition and fee for extension of time under the provisions of 37 CFR 1.136(a).

Applicant is reminded that any communications to the United States Patent and Trademark Office must be mailed to the address given in the heading and include the U.S. application no. shown above (37 CFR 1.5)

Registered users of EFS-Web may alternatively submit their reply to this notice via EFS-Web.  
<https://portal.uspto.gov/authenticate/AuthenticateUserLocalEPF.html>

For more information about EFS-Web please call the USPTO Electronic Business Center at 1-866-217-9197 or visit our website at <http://www.uspto.gov/ebc>.

**If you are not using EFS-Web to submit your reply, you must include a copy of this notice.**

VONDA M WALLACE

Telephone: (703) 308-9140 EXT 225

**PART 2 - OFFICE COPY**

U.S. APPLICATION NUMBER NO.	INTERNATIONAL APPLICATION NO.	ATTY. DOCKET NO.
10/591,806	PCT/US05/07936	P00262US1